

REMARKS

The non-final Office Action mailed December 17, 2010 has been reviewed and these remarks are responsive thereto. Claims 1-10 and 31, 33-40 were presented for examination. Applicants have amended claim 3. No new matter has been added. Support for the amendments can be found at least in the originally filed claims.

Claim Objections

The Office Action objects to claim 3 because of its dependence on cancelled claim 2. Claim 3 has been amended to overcome the objection. Accordingly, Applicants respectfully request the withdrawal of the objection to claim 3.

Claim Rejections Under 35 U.S.C. § 112

The Office Action rejects claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter the Applicants regard as the invention. Applicants respectfully traverse the rejection under 35 U.S.C. § 112. The recitation of an “if-then” statement in a claim does not require the recitation of an “else” statement to be considered a limitation in the claim. In the statement “if X then Y” if X occurs then Y has to occur. This is a limitation because Y must occur when X occurs in the “if-then” statement.

In any open-ended “comprising” method claim any number of possible conditions or steps may be performed. However, an applicant is not required to recite every possible event and an outcome for that event. What the Examiner suggests is that every method claim must recite a step to be performed under every possible condition to not be indefinite. Such a claim would be impossible to draft as every possible condition is not foreseeable. A recitation of “if X then Y” specifies particularly that Y occurs when X occurs.

A claim is not defective when it states fewer than all of the steps that may be performed in practice of an invention. *Smith & Nephew, Inc. v. Ethicon, Inc.*, 276 F.3d 1304 (Fed. Cir. 2001)(citing *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1271 (Fed. Cir. 1986)).

Moreover, “it is not the normal function of a claim to disclose the invention, but to point out the features of novelty in the invention as disclosed in the specification and drawing of the application.” *Bocciarelli v. Huffman*, 232 F.2d 647 (C.C.P.A. 1956). The non-inclusion of an “else” statement in a claim to accompany an “if-then” statement does not render the claim indefinite because the “else” statement is only another step. For example, an “else” statement may instead be written as “if NOT x then Z.” The Examiner can no more require an applicant to recite an “else” statement than the Examiner can require an “if” statement. The Federal Circuit has held that claims are not required to recite all steps that may be performed. *Smith & Nephew, Inc.*, 276 F.3d 1304. Because the Applicants have recited in the claim that which they believe is novel no further limitations are necessary. Thus, the Applicants’ claim 1 is not indefinite for failing to recite an “else” statement.

Further, “every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines.” *In re Wilder*, 429 F.2d 447 (C.C.P.A. 1970). Applicants request that the Examiner consider the “if X then Y” statement because it recites a limitation that Y must occur when X occurs. Applicants respectfully request withdrawal and reconsideration of the rejection under 35 U.S.C. § 112(2).

Claim Rejections Under 35 U.S.C. § 103(a)

A. Claims 1 and 3-10

The current Office Action rejects claims 1 and 3-10 under 35 U.S.C. § 103(a) as being unpatentable over Iliff, U.S. Patent No. 5,594,638 (hereinafter “Iliff”) in view of Ohayon et al., U.S. Patent No. 4,712,562 (hereinafter “Ohayon”), further in view of Brown, U.S. Publication Number 2003/0069753 (hereinafter “Brown”). For the reasons stated below, Applicants respectfully traverse the rejections of claim 1 and 3-10 under 35 U.S.C. § 103(a) over Iliff in view of Ohayon and in further view of Brown.

All elements in a claim must be accounted for to establish a *prima facie* case of obviousness. The prior art cited by the Examiner fails to disclose each element of Applicants’ claim 1. For example, claim 1 recites that “if the answer satisfies the condition, search a

datastore accessible by the remote computer for textual phrases that match the question and automatically generate a clinical note containing the textual phrases for review by the health care professional.” The Examiner concedes that this element is not found in either Iliff nor Ohayon. *See* Office Action, page 4. The Examiner attempts to resolve the deficiency of the combination of Iliff and Ohayon with Brown. However, Brown does not disclose that “if the answer satisfies the condition, search a datastore accessible by the remote computer for textual phrases that match the question and automatically generate a clinical note containing the textual phrases for review by the health care professional” as recited in Applicants’ claim 1.

The Examiner cites Figure 5 and Appendix D (page 61) of Brown as disclosing “searching a datastore accessible by the remote computer for textual phrases that match the question” as recited by Applicants’ claim 1. *See* Office Action, page 5. Figure 5 is merely a script entry screen for input possible questions and answers in a survey. *See* Brown, paragraphs 54, 107, and 108. Appendix D is a disclosure of an “Alternate User Interface Design” wherein “each button is equivalent to a tab” and selection of the buttons “changes the content view underneath the button control area.” *See* Brown, Appendix D on page 61. Applicants can locate no relevant disclosure in Figure 5 or page 61 to the recitation in Applicants’ claim 1 of “searching a datastore accessible by the remote computer for textual phrases that match the question.”

The Examiner cites Figure 2 and paragraphs 41, 44, 105, and 115 of Brown as disclosing “automatically generat[ing] a clinical note containing the textual phrases for review by the health care professional” as recited in Applicants’ claim 1. *See* Office Action, page 4. Brown does not disclose generating a clinical note containing textual phrases for the health care professional’s review as stated by the Examiner. According to Applicants’ claim 1 the textual phrases placed in the clinical note are retrieved from a datastore accessible by the remote computer that match the question. In Brown, no searching for textual phrases occurs. Instead, Brown discloses that the “[p]atient report includes a graph of device measurements received from the patient, as well as a listing of response received from the patient.” *See* Brown, paragraph 105. The patient report of Brown is different from the clinical note recited in Applicants’ claim 1 because the

patient report is only a recitation of received responses and measurements whereas the clinical note contains textual phrases matching received responses from the patient obtained from searching a datastore.

Applicants note that the Examiner responded to Applicants' previous argument by stating that Brown, not Ohayon, was cited for the feature of searching a database for textual phrases that match the question and automatically generate a clinical note containing the textual phrases. *See* Office Action, page 12. However, as described above, Brown does not disclose this limitation recited in Applicants' claim 1.

In determining obviousness, an Examiner is required to consider every claim feature. M.P.E.P. § 2143.03. To reject a claim under 35 U.S.C. § 103 each and every claim feature must be accounted for in the prior art combination. *In re Royka*, 490 F.2d 981 (CCPA 1974). Because neither Iliff nor Ohayon nor Brown disclose all of the limitations of Applicants' claim 1 no *prima facie* case of obviousness exists. As such, claim 1 is allowable over the prior art of record. Claims 3-10 are dependent on allowable claim 1 and are allowable for at least the same reasons. Applicants respectfully request reconsideration and withdrawal of the rejection.

A. Claims 31 and 33-40

The current Office Action rejects claims 31 and 33-40 under 35 U.S.C. § 103(a) as being unpatentable over Iliff in view of Ohayon in view of Brown, further in view of Luttrell, U.S. Patent No. 4,712,562 (hereinafter "Luttrell"). For the reasons stated below, Applicants respectfully traverse the rejections of claim 31 and 33-40 under 35 U.S.C. § 103(a) over Iliff in view of Ohayon, in view of Brown, in further view of Luttrell.

Applicants note that in response to Applicants' previous argument the Examiner has conceded that the combination of Iliff, Ohayon, and Brown do not disclose all of the recited elements in Applicants' claim 31. *See* Office Action, pages 12-13. In particular, neither Iliff, Ohayon, nor Brown disclose "automatically creat[ing], in response to determining that the person should have health care professional attention, an entry in an intervention data field for the person, the entry describing a treatment to counteract a symptom experienced by the person" as

recited in Applicants' claim 1. The Examiner has attempted to cure the deficiency of the combination of Iliff, Ohayon, and Brown with Luttrell. However, Luttrell does not disclose this element. Moreover, Luttrell teaches away from Applicants' claim 1.

Luttrell discloses logging treatments performed on a patient by a health care professional, which is not the same entry automatically created by the Applicants' claim 31 in response to determining that the person should have health care professional attention. Luttrell discloses that "[a]s a result of each treatment session, each identified goal (whether generated at this treatment session or as a result of a prior session) will have a Treatment Record 96A-96C generated therefor." *See* Luttrell, paragraph 58. In contrast, the intervention automatically created as recited in Applicants' claim 31 occurs "in response to determining that the person should have health care professional attention." Thus, the intervention is logged before the health care professional is contacted. In Luttrell, the logging occurs after the health care professional performs treatment, which is after the health care professional is notified. Luttrell does not disclose "automatically creat[ing], in response to determining that the person should have health care professional attention, an entry in an intervention data field for the person, the entry describing a treatment to counteract a symptom experienced by the person" as recited in Applicants' claim 31.

Moreover, Luttrell teaches away from Applicants' claim 31 because Luttrell is directed to creating records after treatment has occurred. The automatic logging of treatments in Luttrell is for the purpose of "automatically generating reports requested by a multitude of separate payors from whom payment is eventually sought by the provider once treatment has been rendered." *See* Luttrell, paragraph 58. In contrast, Applicants' claim 31, as described above, is directed to identifying when health care professionals should be alerted. Luttrell cannot be adapted to log entries before health care professionals are alerted because it would render Luttrell inoperable for creating reports requesting payment for services already performed. Where a modification would render the device inoperable for its intended purpose there is no suggestion or reason to modify a prior art reference. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). There is no suggestion or reason to modify Luttrell as suggested by the Examiner because the modification

would render Luttrell inoperable for its intended purpose. Thus, the combination of Luttrell with Iliff, Ohayon, and Brown is improper.

For at least the reasons described above claim 31 is allowable over the prior art of record. Claims 33-40 are dependent on allowable claim 31 and are allowable for at least the same reasons. Applicants respectfully request reconsideration and withdrawal of the rejection.

Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Additionally, the Commissioner is hereby authorized to charge any additional fees as set forth in 38 CFR §§ 1.16 to 1.18 which may be required for entry of these papers or to credit any overpayment to Deposit Account No. 50-1212, under Order No. CARD.P0006US from which the undersigned is authorized to draw.

Dated: March 17, 2011

Customer No. 38824

Respectfully submitted,

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